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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/567,565	02/08/2006	Toru Kontani	Q92689	6627
65565 7590 04/24/2008 SUGHRUE-265550 2100 PENNSYLVANIA AVE. NW WASHINGTON, DC 20037-3213				
EXAMINER				
HABTE, KAHISAY				
ART UNIT		PAPER NUMBER		
1624				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/567,565

Applicant(s)

KONTANI ET AL.

Examiner

Kahsay T. Habte

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 55-66 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 55-66 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/55/08)
Paper No(s)/Mail Date 5/17/06 and 2/8/06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

1. Claims 55-66 are pending in this application.

Information Disclosure Statement

2. Applicant's Information Disclosure Statement, filed on 05/17/2006 and 02/08/2006 has been acknowledged. Please refer to Applicant's copies of the 1449 submitted herewith.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 55-66 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,903,125. Although the conflicting claims are not identical, they are not patentably distinct from each other because there is significant overlap between claims 55-66 of the instant case and claims 1-9 of U.S. Patent No. 6,903,125 when formula (I) of the instant case has the following substituents: A = phenyl; X = CO; R3 = saturated heterocyclic ring; and Z = 1,2,4-oxadiazol-3-yl and 4-oxazolyl.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 66 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not

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described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In evaluating the enablement question, several factors are to be considered. Note *In re Wands*, 8 USPQ2d 1400 and *Ex parte Forman*, 230 USPQ 546. The factors include: 1) The nature of the invention, 2) the state of the prior art, 3) the predictability or lack thereof in the art, 4) the amount of direction or guidance present, 5) the presence or absence of working examples, 6) the breadth of the claims, and 7) the quantity of experimentation needed.

The scope of the claims is not adequately enabled solely based on the anti-herpes virus activity provided in the specification. First, the instant claims cover 'diseases' that are known to exist and those that may be discovered in the future, for which there is no enablement provided. The use disclosed in the specification is as a pharmaceutical agent, more particularly a prophylaxis and therapeutic treatment of diseases in which herpes virus is involved. Test procedures and assays are provided in the specification at pages 32-37 only for 4 compounds and it is concluded that the representative compounds of formula (I) demonstrated positive inhibitory activity with IC_{50} ranging from 80% to 100%, however, there is nothing in the disclosure regarding how this *in vitro* data correlates to the treatment of the diverse disorders embraced the instant claims. The disorders encompassed by the instant claims (i.e. treatment of diseases in which herpes virus is involved), some of which have been proven to be extremely difficult to treat. There is no reasonable basis for assuming that the myriad of

compounds embraced by the claims will all share the same physiological properties since they are so structurally dissimilar as to be chemically non-equivalent and there is no basis in the prior art for assuming the same. Note *In re Surrey*, 151 USPQ 724 regarding sufficiency of disclosure for a Markush group.

The instant claim 66 recites, "A method for treating diseases in which herpes virus is involved", but said claim appear to be a 'reach through' format. Reach through claims, in general have a format drawn to mechanistic, receptor binding or enzymatic functionality and thereby reach through any or all diseases, disorders or conditions, for which they lack written description and enabling disclosure in the specification thereby requiring undue experimentation for one of skill in the art to practice the invention.

The claims are drawn to 'treating diseases in which herpes virus is involved ', however, there is no common mechanism by which all conditions due to herpes virus infections arise. According to Dr. Richard Hunt, MICROBIOLOGY AND IMMUNOLGY ON-LINE at <http://pathmicro.med.sc.edu/virol/herpes.htm>, herpes virus is a leading cause of human viral disease and there are at least 25 viruses in the family. As shown in this 19 pages article, herpes virus is very complex and causes myriad diseases that are different one from the other.

Thus, factors such as "sufficient working examples", "the level of skill in the art" and "predictability", etc. have been demonstrated to be sufficiently lacking in the use of the invention. In view of the breadth of the claim, the chemical nature of the invention, the unpredictability of ligand-receptor interactions in general, and the lack of working examples regarding the activity of the claimed compounds, one having ordinary skill in

the art would have to undergo an undue amount of experimentation to use the invention commensurate in scope with the claims.

It is recommended that applicants amend the claim as "A method of treating herpes virus infection" to overcome this rejection.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 55-66 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention:

a. Claim 1 and claims dependent thereon are rejected because the phrase "may have a substituent(s)" is indefinite. In the absence of the specific moieties intended to effectuate modification by the substitution or attachment to the chemical core claimed, the term "substituent(s)" renders the claims in which it appears indefinite in all occurrences wherein applicants fails to articulate by chemical name, structural formula or sufficiently distinct functional language, the particular moieties applicants regards as those which will facilitate substitution, requisite to identifying the composition of matter claimed.

b. In claim 57 (page 5, lines 8-10), the terms "[3.1.O]", "pezhydro-1,3-thiazinyl", and "piperadinyI" are not clear. Is this a typographic error? It is recommended that applicants review the substituents of R3 at page 5 and fix the problem.

c. In claim 66, the phrase "diseases in which herpes virus is involved" is indefinite. What is covered and what is not?

Objection

7. Claim 55 is objected to because of the recitation of "general formula (I)". A formula should be specific one such as formula (I) , formula A, etc. and not a general one. It is recommended that applicants delete "general" to overcome this objection.
8. Claim 65 duplicates claim 64. Claim 64 and claim 65 are all drawn to the same compositions. Note that e.g. a pill is the same pill regardless of whom it will be given to.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kahsay Habte, Ph. D. whose telephone number is (571) 272-0667. The examiner can normally be reached on M-F (9:00AM- 5:30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached at (571) 272-0661. The fax phone

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number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Kahsay T. Habte/
Primary Examiner, Art Unit 1624

KH
April 23, 2008